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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/219,935 12/23/98 BROWSE

J BB-1036-B

EXAMINER

HM12/0829

LEGAL PATENT RECORDS CENTER
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WILMINGTON DE 19898

MCELWAIN, E

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/219,935

Applicant(s)

Browse

Examiner

Elizabeth McElwain

Group Art Unit

1638



☒ Responsive to communication(s) filed on Jun 23, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1 and 20-28 is/are pending in the application

Of the above, claim(s) 25 is/are withdrawn from consideration

☒ Claim(s) 20 is/are allowed.

☒ Claim(s) 1, 21-24, and 26-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

This application contains claim 25 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

5 Claims 1 and 20-28 are pending.

 Claims 1, 20-24 and 26-28 are examined on the merits.

 The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10 Claims 1 and 24, and claims 21-23 and 26-28 dependent thereon are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

 Claim 1 remains indefinite in the recitation of "desaturase-related", given that it is unclear what would be encompassed by this term, as stated in the last office action.

15 Claim 24 is indefinite in the recitation of "desired fatty acid phenotype", given that any fatty acid phenotype may be desirable, and therefore this phrase does not set forth the metes and bounds of the claimed invention.

 Claim 24 remains rejected under 35 U.S.C. 101 because the claimed invention is
20 directed to non-statutory subject matter. Claim 24 is drawn to seeds obtained from the plant of

claim 23 that have a desired fatty acid phenotype. However, there is no indication that the claimed seeds are distinguishable from those which would occur in nature.

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-
5 type double patenting as being unpatentable over claims of copending Application No. 08/244,205, given that the terminal disclaimer was not deemed proper. The attorney that signed the terminal disclaimer is not of record on the oath or declaration, and has not been indicated as an official officer for the case by submission of a Power of Attorney. Submission of a Power of Attorney for Lynne Christenbury would provide the needed documentation.

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Claim 20 is in condition for allowance.

Applicants' arguments filed June 23, 2000 have been fully considered but they are not persuasive.

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Applicants assert that the rejection of claims as indefinite in the recitation of "desaturase-related" should be withdrawn in view of the definition provided at page 17 of the specification, which states that this would not result in the production of a carbon-carbon double bond, but would have a mechanism of action similar to a fatty acid desaturase, giving an example of this including formation of a fatty-hydroxyacyl intermediate or end-product.

20

The Examiner maintains the rejection given that applicants have defined the activity of "desaturase-related", by what it is not, while it remains uncertain what types of enzyme

activity would be encompassed by the claims. In addition, it is unclear how such enzymes would be related to desaturases, given that the activity of desaturases is in the formation of carbon-carbon double bonds.

5 Applicants assert that the rejection of claim 24 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, should be withdrawn given the amendment of the claim.

The Examiner maintains the rejection given that claim 24 is now drawn to seeds obtained from the plant of claim 23 that have a desired fatty acid phenotype. However, there
10 is no indication that the claimed seeds are distinguishable from those which would occur in nature, given that any seed may have a desired fatty acid phenotype.

Applicants assert that the provisional rejection of the claims under the judicially created doctrine of obviousness-type double patenting should be withdrawn in view of the submission
15 of a terminal disclaimer.

The Examiner maintains the rejection in view of the deficiency cited above in the statement of the rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this
20 Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 26, 2000

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 4800-1600
